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09/992,809	11/19/2001	Robert Kelly Mulhern	E0019/261139	7341

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EXAMINER

ROBINSON, GRETA LEE

ART UNIT	PAPER NUMBER
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2168

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,809

Applicant(s)

MULHERN ET AL.

Examiner

Greta L. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-53 are pending in the present application.
2. Claims 1, 19, 18, 28, 33, 36, 39, 42, 45 and 48 have been amended.

Drawings

3. The drawings are objected to because Figure 4 contains partial views, note 37 CFR 1.84(h). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show logical flow details as described in the specification [note: Figures 2 and 3, page 7 line 16 through page 9 line 23]. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

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Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-8 and 48-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim appears to be directed to an abstract idea and does not present a concrete tangible result. Note the claim recites a step for generating a “non-matched customer file”, but does not present a link in terms of updating a customer file. The claim recites assigning a UCID in “the customer file” but does not specify *which* customer file (i.e. “matched customer file” and/or “non-matched customer file”) is assigned the UCID. Claims 2-8 and 49-53 are rejected based on dependency.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1-53 the specification does not appear to describe the limitation of a “UUID is maintained without disclosure to the customer” [note: claim 1 lines 12-13; claim 9 lines 8-9; claim 18 lines 7-8; claim 28 lines

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10-11; claim 33 lines 8-9; claim 36 lines 12-13; claim 39 line 8; claim 42 line 8; claim 45 line 8; claim 48 line 15].

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-53 the following limitation is not clear "the UUID is maintained without disclosure to the customer". The term without disclosure is not clear and does not appear to be described in the specification.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-16, 18-26, 28-31 and 33-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charles D. Morgan (U.S. Patent No. 6,073,140 and Morgan 140 hereinafter) in view of Charles D. Morgan, Jr. (U.S. Patent No. 6,766,327 and Morgan-327 hereinafter).

Regarding Claims 1, 3, 6, 9, 11, 18-19, 28, 30, 33, 36, 38-39, 42, 45, 48 and 5051, Morgan discloses: receiving raw data corresponding to at least one event generating entity (Col 1 Lines 38-50; see also Col 3, Lines 53-61); processing the raw data and generating at least one processed record entry (Col 3, Line 54 and 57-61, i.e. data structure; see also Col 1 Lines 38-50); storing a plurality of processed record entries in a universe database (Figure 1, Element No. 114, and corresponding text; see also Col 1 Lines 38-50) each record entry

being associated with a unique universe identifier ("UUID") (Figure 1, Element No. 114, and corresponding text; see also Col 3, Lines 52-54); accessing content of a customer file (Figure No. 2, Element No. 214 and corresponding text; see also Col 3, Lines 61-64); comparing the content of the customer file with the content of the universe database (Col 3, Lines 61-64; see also Col 11, Lines 38-42); generating a matched customer file (Col 6, Lines 53-59; See also Col 10, Lines 27-36); assigning a unique customer number ("UCID")² for each record entry contained in the customer file (Col 5, Lines 7-8; see also Col 10, Lines 13-26); associating each UCID with a corresponding UUID (Abstract, see also Col 5, Line 59 through Col 6, Line 3; see also Col 12, Lines 62-67, i.e. join table)³; and updating a portion of at least one record entry in the matched customer file with information contained in the processed record entry associated

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with the UUID corresponding to the UCID associated with the at least one record entry (Col 3, Lines 35-51; see also Col 7, Lines 11-20).

The Examiner is interpreting the "UUID" to be similar to the persistent keys for records in the vendor's database, also referred to as the "center database" (universe database). The Examiner is interpreting the "UCID" to be similar to the persistent keys for records in the data customer's customer database. The Examiner is interpreting both ID's to be the same as the persistent key; as the Morgan reference is disclosing a persistent key for records in the central database, which is the vendor's database (universe database); and the other persistent key for records in the customer database. Please note that these persistent keys are unique (Morgan, Col 3, Lines 52-64). Please note that the Examiner is taking into consideration dependent Claim 6 in interpreting this limitation for associating these keys.

Morgan '140 reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate "wherein the UCID is different from the UUID, and the UCID is capable of being distributed to a single customer and the UUID is capable of being maintained without disclosure to the customer". However, Morgan '327 discloses the above limitation of "wherein the UCID is different from the UUID, and the UCID is capable of being distributed to a single customer and the UUID is capable of being maintained without disclosure to the customer", (Col 6, Lines 6-48). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Morgan '140 with the teachings of Morgan '327 to distribute one ID such as the UCID and maintain the other ID such as the UUID to prevent the plurality of the receiving clients (the party receiving the UUID's) from sharing the data between themselves which leads to the elimination of the need to the Information Service Providers (see Col 6, Lines 23-30).

The combinations of both Morgan '140 and Morgan '237 references disclose all of the claimed subject matter set forth above, except they do not explicitly indicate the generating of a non-matched customer file. However, given the nature of database searching, the Examiner takes Official Notice that it was well known in the art to generate a non-match list when a database conducts a search according to criteria will generate a match list; on the other hand all other records that were not included in this match list will be part of a non-match list. Hence, Including a non-match list in the combination of both references would have been obvious to

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one of ordinary skill in the art at the time the invention was made. As such, a list (non-matching list) may be useful in increasing sales, in this case sales of data relating to entities, for example, individuals or consumers to those who are interested (data purchasers) especially since they don't have this list. Another good reason would be for marketing research; as a data purchaser would like to have an idea or compare the matching list to the non-matching list relating to a certain criteria in order to make better decisions; for example, deciding on promoting a certain product in a certain geographic location, does the majority of the residence of this location make enough income to actually afford such an item or product (Morgan-140, Col 1, Lines 52-57).

Regarding Claims 2, 26, 31, 34, 37, 40, 44, 46 and 49, Morgan discloses wherein each UUID and UCID are stable over a period of time (Col 4, Line 66 through Col 5, Line 6; see also Col 5, Lines 48-51).

Regarding Claim 4, Morgan discloses wherein the action of comparing the content of the customer file with the content of the universe database comprises organizing the record entries in the customer file per person (Col 10, Lines 13-26) i.e.

Key field 612 is chosen as that field from each record that can be easily used to match the record on customer database 210 that contains complementary information. For example, if central database 224 maintains a record with all known information on individual John Doe, the key field 612 from that record might be the last name field, "Doe.".

Regarding Claims 5, 13-16, 20-22 and 24-25, Morgan discloses wherein the action of comparing the content of the customer file with the content of the universe database comprises using public domain identity data common to the customer file and the universe database (Col 5, Lines 59-64; see also Col 9, Lines 44-60: see also Col 5, Lines 18-24, i.e. such as direct satellite links).

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Regarding Claims 7-8, 12, 23 and 52-53, Morgan discloses wherein the action of updating a portion of at least one record entry is accomplished using a batch mode or near real-time (Col 13, Lines 17-24).

Regarding Claim 10, the limitations of this claim is similar in scope to the rejected claims 1 and 2, above. It is therefor rejected as set forth above.

Regarding Claim 29, Morgan discloses wherein each set of the UCID's is different from another set of the UCID's (Col 5, Lines 29-38; see also Col 4, Lines 6-22).

Regarding Claims 35 and 41, the limitations of this claim has been noted in rejecting claim 6, above. In addition, Morgan discloses wherein the UCID's are updated with a new UCID's (Col 11, Lines 15-27).

Regarding Claims 43 and 47, Morgan discloses wherein the action of transferring the at least one data file occurs after determining the state of an attribute (version number) associated with the at least one data file (Col 11, Lines 15-27).

Response to Arguments

14. Applicant's arguments filed September 26, 2006 have been fully considered but they are not persuasive.

In the response Applicant argued the following:

- The independent claims have been amended to clarify that the UCID is capable of being distributed to a single customer, the use of a UCID distributed or sent to a single customer in the claimed invention is dissimilar to a direct table join described by Morgan because it eliminates the requirement of sending data or a list of keys to any data vendor.
- RESPONSE: Prior art reference Morgan '327 does not limit the distribution, they are concerned with creating unique links for proper

identification of information. Provision of a single user or multiple users receiving the data is possible [note: abstract; col. 6 line 45 col. 7 line 12].

Also note the present inventions disclosure admits variation within transmission to number of users note page 7 lines 19-22. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., eliminates the requirement of sending data or a list of keys to any data vendor) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- The conversion table (CT) is used to associate a UUID with UCID this is different than the prior arts client specific key, encoding/decoding algorithms and stored algorithm/lookup table which is relatively more complex. The CT can provide mapping, linking, and associating.
- RESPONSE: The stored algorithm/lookup table performs the same function as the conversion table, i.e. mapping, linking and associating data, the specification does appear to define functionality that is different. Note Morgan '327 Figure 4 and 6 and citations above.

Conclusion

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15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Haimowitz et al. US Patent 5,819,291

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Greta Robinson
Primary Examiner
August 30, 2006



GRETA ROBINSON
PRIMARY EXAMINER